

### ARGUMENTS/REMARKS

The above-identified patent application has been reviewed in light of the Examiner's Office Action dated September 4, 2009 and the Advisory Action dated December 18, 2009. In view of the arguments presented herein, Applicant respectfully submits that the claims are in condition for allowance.

The Examiner indicated in the Advisory Action that all rejections presented in the Office Action under 35 U.S.C. §112, paragraph 2, were addressed and that all outstanding objections were obviated. The Examiner however maintained the rejections of Claims 11, 12, 14 and 21-23 under 35 U.S.C. §103(a) as being unpatentable over Gebert and Fritz; Claims 13 and 15 under 35 U.S.C. §103(a) as being unpatentable over Gebert, Fritz and Ball '241; and Claims 16-20 under 35 U.S.C. §103(a) as being unpatentable over Gebert, Fritz and further in view of Ball '931 and Ball '241.

Claims 11- 23 are pending.

#### **Claim Rejections 35 USC §103 - Gebert and Fritz**

The Examiner has rejected Claims 11, 12, 14 and 21-23 as being obvious in view of a combination of Gebert and Fritz. Gebert has been cited for disclosing the majority of the features claimed and Fritz has been cited primarily for disclosing a removable diaphragm. Applicant traverses this rejection because evidence of record establishes that Applicant has properly sworn behind Fritz. Fritz, thus, cannot be considered prior art and the claims are in a condition for allowance. Alternatively, Applicant requests that this rejection be withdrawn as the combination of Gebert and Fritz does not meet the *prima facie* test for obviousness.

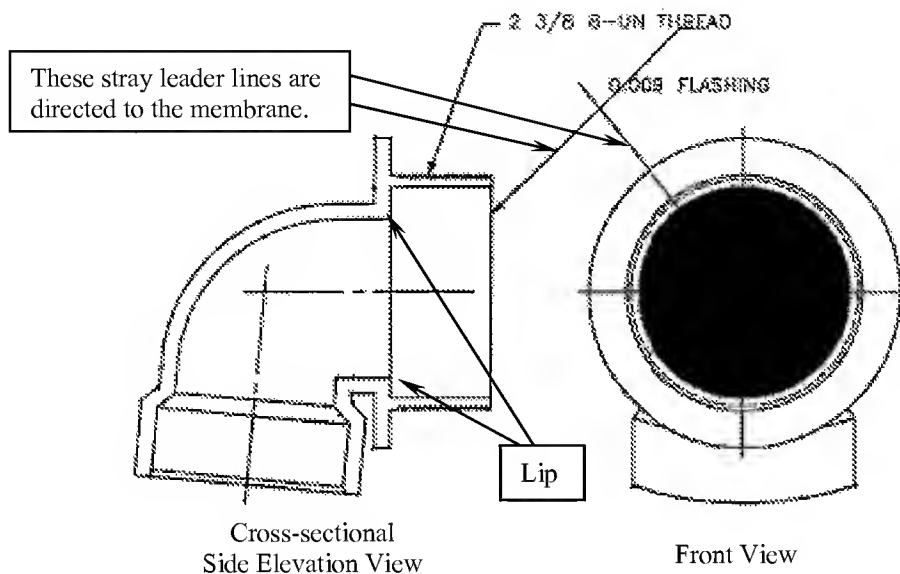
#### *Fritz*

Withdrawal of the rejection based on a combination of Fritz and Gebert is requested. As the evidence reflects, the claimed invention enjoys a date of conception that predates the filing date of Fritz, and the requisite diligence existed from the date of conception until constructive reduction to practice (i.e., filing date of the '724 application and applications related thereto).

In the Final Office Action the Examiner confirmed that Exhibit B of Inventor Ball's Declaration under Rule 131 (also denoted as Fig. 4), dated February 9, 2000, disclosed a

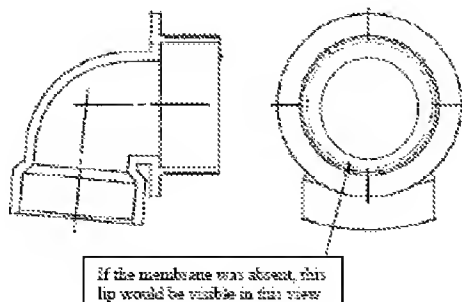
membrane for preventing fluid flow. The Examiner also noted that the date associated with Exhibit B was subsequent to the December 1, 1999 filing date of Fritz. The Examiner failed to appreciate, however, that the submitted engineering drawing Exhibit A of that Declaration, dated December 7, 1999, also showed the same membrane.

More specifically, provided below is an annotated excerpt of Exhibit A showing the membrane<sup>1</sup>.



In the present case, the independent draftsman's declaration is sufficient corroborating evidence to establish conception earlier than Fritz. Mr. Carlson declares that it usually takes him 3-4 weeks to produce such drawings from an initial disclosure, and

<sup>1</sup> Pursuant to normal engineering drawing practices, the front view would show the lip if a membrane was absent. See the illustration below.



therefore concludes that conception must have occurred in November of 1999 – BEFORE THE FILING DATE OF FRITZ – December 1, 1999.<sup>2</sup>

A corroborated statement of an inventor is sufficient to establish a date of conception. Reese v. Hurst, 661 F.2d 1222, 1225 (CCPA 1981)(“Independent corroboration may consist of testimony of a witness, other than the inventor, to the actual reduction to practice or it may consist of evidence of surrounding facts and circumstances independent of information received from the inventor.”)(emphasis added). This governing law has been relied upon by the Federal Circuit in situations arising from civil litigation, as well as from appeals from the Board of Patent Appeals. See, e.g. In re Gardner, 508 F.3d 1376 (Fed. Cir. 2007).

Sufficiency of corroboration is determined by using a “rule of reason” analysis, under which all pertinent evidence is examined when determining the credibility of an inventor’s testimony. Price v. Symsek, 988 F.2d 1187, 1195 (Fed. Cir. 1993). Here, a rule of reason analysis would include the other pertinent evidence establishing the credibility of the inventor’s testimony, including that the invention was conceived around his birthday of 10/10/99 birthday; his move from Kansas City and his transition to a Vice President position.<sup>3</sup> Together with Mr. Carlson’s declaration, such evidence reasonably establishes that Fritz cannot properly be relied upon to support an obviousness rejection under section 103. See, Cooper v. Goldfarb, 154 F.3d 1321, 1327 (Fed. Cir. 1998) (“It is not necessary

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<sup>2</sup> The following is an excerpt from Mr. Carlson’s declaration:

6. Upon information and belief, the first concept drawings were completed by me on December 7, 1999. Exhibit A is a copy of engineering drawings I provided to Mr. Ball where my initials “BC” may be found near the date shown on the drawing.

7. Upon information and belief, it usually takes me about three to four weeks to perform modeling and drafting activities associated with a conceptual design. Therefore, Mr. Ball must have disclosed the invention to me at least in November of 1999.

<sup>3</sup> The following is an excerpt from Mr. Ball’s declaration:

5. Upon information and belief, the claimed invention was conceived prior to December 1, 1999. I hereby declare that I conceived the invention in October of 1999. I recall the conception of the invention as it was two weeks subsequent to my birthday of October 10 and generally around the time of my move from Kansas City, MO and my transition from Watco to Woodford as Vice President of Engineering.

6. Upon information and belief, after I discussed the concept, then referred to the Schedule 40 Overflow Elbow and later referred to the Innovator, with Mr. Bill Carlson, a designer/drafter employed by Woodford, in at least November of 1999.

to produce an actual over-the-shoulder observer. Rather, sufficient circumstantial evidence of an independent nature can satisfy the corroboration requirement.”).

It is respectfully requested, in view of the cited legal precedent and the undisputed evidence of record, that the Examiner withdraw the 103 rejections and pass all claims to allowance. As this case has been pending since 2003, Applicant believes that all applicable prior art has by now been located, considered and cited.

#### *Gebert and Fritz*

Applicant incorporates by reference the arguments related to Gebert in previously submitted Responses (see for example, pgs. 10-12 of the Amendment and Response After Final dated December 14, 2009).

Because Fritz is not prior art, it cannot be combined with Gebert to properly support a §103 rejection. Furthermore, Gebert is different in several respects and Fritz does not cure such deficiencies. Thus withdrawal of the rejection to Claims 11, 12, 14 and 21-23 is respectfully requested.

#### **Claim Rejections 35 USC §103 - Gebert, Fritz and Ball ‘241**

The Examiner rejected Claims 13 and 15 as being obvious in view of a combination of Fritz and Ball. Generally, Gebert has been cited as disclosing the majority of the features claimed and Fritz has been cited for disclosing a removable diaphragm. Ball has been cited for teaching a cutting instrument. For the reasons outlined above, Applicant asserts that Fritz is not prior art that can be combined with Gebert and Ball ‘241. Alternatively, the combination of Gebert, Fritz and Ball ‘241 does not include each of the elements claimed, and in support of this position, Applicant incorporates arguments previously submitted in the present prosecution as if fully set forth herein.

Accordingly, Claims 13 and 15 are believed to be allowable and withdrawal of this rejection is respectfully requested.

#### **Claim Rejections 35 USC §103 - Gebert, Fritz, Ball ‘931 and Ball ‘241**

The Examiner rejected Claims 16-20 as being obvious in view of a combination of Gebert, Fritz, Ball ‘931 and Ball ‘241. Generally, Gebert has been cited as disclosing the majority of the features claimed and Fritz has been cited for disclosing a removable

diaphragm. The Ball references have been cited for disclosing a bath tub plumbing system, etc. For the reasons outlined above, Applicant asserts that Fritz is not prior art that can be combined with Gebert, Ball '931 and Ball '241. Alternatively, Applicant asserts that this combination of references does not include each of the elements claimed, and in support of this position, Applicant incorporates arguments previously submitted in the present prosecution as if fully set forth herein. Accordingly, Claims 16-20 are believed to be allowable and withdrawal of the §103 rejection is therefore requested.

### **Conclusion**

Applicant would appreciate it if the Examiner would reach out and contact Applicant's counsel to work toward defining the metes and bounds of the invention to be patented. See, In re David Buszard, 2006-1489 (Fed. Cir. 2007), ("Thus the patent examiner and the applicant, in the give and take of rejection and response, work toward defining the metes and bounds of the invention to be patented. See In re Zletz, 893 F.2d 319, 321-22 (Fed.Cir. 1989)...." Director Kappos recently stated that he is "hearing from applicants that they truly appreciate that examiners are reaching out to them, offering to help, engaging in a cooperative search for allowable subject matter..." (Kappos blog, Jan. 26, 2010.). Applicant's counsel welcomes any and all suggestions to expedite prosecution of this long pending case.

Applicant has made good faith *bona fide* attempt to advance the application by distinctly and specifically pointing out the supposed errors in the Examiner's action and have further attempted to reply to every ground of objection and rejection in the prior Office action by presenting arguments pointing out the specific distinctions believed to render the claims patentable over the applied references. Applicant requests that any objections or requirements as to form be held in abeyance until allowable subject matter is indicated.

Based upon at least the foregoing, Applicant believes that all pending claims are in condition for allowance and such disposition is respectfully requested. In the event that a telephone conversation would further prosecution and/or expedite allowance, the Examiner is invited to contact the undersigned.

Moreover, pursuant to MPEP 714.12, Applicant further requests that a personal interview should be granted and Examiner Fetsuga is invited to initiate such interview if in his judgment this would materially assist in placing the application in condition for allowance.

Respectfully submitted,

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